initial results = test results

REMARKS

Status of the Claims

Claims 1-9, 11-14, 16, 18, 21, 22, and 27-41 remain pending the application. Applicants have made minor amendments in form, but not to the substantive content, to Claims 1, 2, 7, 9, 12, 29, 33, 35, and 41, to more clearly define the present invention.

Claims Rejected Under 35 U.S.C. § 102(e) over Hobbs

The Examiner has rejected Claims 1, 2, 5, 7, 8, 11, 13, 21, 27, 29, 30, 33, 35, and 38 as being anticipated by Hobbs (U.S. Patent No. 5,987,454, hereinafter "Hobbs"). The Examiner asserts that Hobbs teaches each element of applicants' claimed invention. Applicants respectfully disagree for the reasons discussed below.

In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1 and 29. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

With regard to independent Claim 1, applicants' recited claim language concerning the step of presenting the test search results to a user for a determination as to whether the test search results are desirable, is neither taught nor suggested by Hobbs. Applicants' claimed method first returns ***test*** search results for consideration by a user, and subsequently also returns search results when the search link embedded in the genesis document is activated. These two steps are not taught or suggested by Hobbs. In applicants' claimed method, a test search is initiated by depressing the test search button that instructs the search engine to search the site catalog for all

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documents meeting the parameters specified in the search criteria dialogue (see applicants' specification, page 22, lines 22-26). The site catalog is a compilation of all documents found by the search engine and determined, by the Boolean filter, to be relevant to potential search requests received from the search criteria dialogue (see applicants' specification, page 12, lines 16-19). Once all the relevant documents have been retrieved, the documents are presented to the user, and the user can thus see the "results" that will be generated when a third party accesses a search link with parameters corresponding to those specified in the search criteria dialogue (see applicants' specification, page 22, lines 27-31). The user can also create a search link at this point (see applicants' specification, page 23, lines 5-6). Hence, these "results" are test search results.

Later, users will access the "newly created" search link, activating a search employing the same parameters originally specified by the link creator in the search criteria dialogue (see applicants' specification, page 26, lines 10-14). The results seen by a user in this later search may differ from the test search results, because the site catalog is periodically updated. Updates may eliminate some documents or files, and add others. Thus, the specific documents can vary widely (see applicant's specification, page 26, lines 18-20). Hence, these "results" may be different and are referred to simply as "search results" to distinguish them from the initial "test search results."

Thus, two sets of results are returned using applicants' claimed method. A searchable document set is created (see applicants' specification, page 2, line 34) using the test search results as described above. For example, an administrator may conduct the test search and create a search-enabled curriculum standards document for discovery and use by teachers (see applicants' specification, page 6, lines 20-21). Teachers are then able to retrieve the curriculum standards document that has been saved in HTML format and may specify a new search (see applicants' specification, page 8, lines 21-35).

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The Examiner asserts that Hobbs discloses the fourth step of Claim 1 concerning presenting the test results to a user for a determination as to whether the test results are desirable and cites item (iv) in Hobbs' abstract. In this item, Hobbs' abstract states that his method"presents to the user the results of a search of the Data Warehouse or database through a graphical user interface which coordinates and correlates viewer selection criteria with the expert optimum remote database selection and queries." The results of this database search that the abstract refers to is presented to the user with a "menu of choices...corresponding to a selection of text, audio...or documents" from which the user can choose (Hobbs, column 23, lines 63-67). And once the user makes a choice, the database will deliver the document corresponding to the choice in frame 1 (Hobbs, column 24, lines 10-12). So the user will be able to interactively access a range of expert pre-selected individual databases or database in Data Warehouses linked to the Linked Terms appearing in the framed windows of the browser (Hobbs, column 11, page 14-18). In contrast, applicants' test search results are obtained by downloading from a number of Internet sites, starting at central "hub sites" and working outward through the use of World Wide Web or other Internet links (see applicants' specification, page 14, lines 10-15); discarding or assigning each page to a site (see applicants' specification, page 15, lines 35-36); and then applying a Boolean filter (applicants' specification, page 16, lines 6-10). Applicants' recited test search results are therefore very different from Hobbs' results shown in the frame, which are from expert pre-selected databases. Also, applicants' test search results are broken down into pages and are not equivalent to Hobb's results that are still in database form.

Furthermore, applicants' Claim 1 recites the step of: "in response to the determination that the test search results are desirable, embedding a search link corresponding to the search parameters into the genesis document to create the embedded search link document, the search link being operative, when activated, to initiate a search of the document source for search results that match the search parameters and to retrieve the search results." This step is neither taught nor suggested by Hobbs.

In applicants' claimed method, if the test search results are desirable to the user, the user can choose to embed a search link (i.e., a hyperlink) in the genesis document (see applicants' specification, page 4, lines 12-15). When a user activates the search link, the target of the search link "is a domain specific search engine along with all the search parameters the author specified" (see

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applicants' specification, page 4, lines 15-20). In this manner, the search engine offers up-to-date hyperlinks containing the author's knowledge of good web resources (see applicants' specification, page 2, lines 26-28). For example, teachers can now employ the embedded search link document, which may have been created by an administrator, in order to retrieve appropriate lesson plans (see applicants' specification, page 3, lines 29-32).

The Examiner asserts that Hobbs anticipates this step and refers to the preamble of Claim 1 in Hobbs that recites "a method of dynamically augmenting the contents of at least one file of information on a first network resource, said file of information having at least one link, said method comprising the steps of...." As shown in Hobbs' FIGURE 5A, step 249, a user may choose to review a web site and employ a browser to make the request to see a document file on the Document Server. Hobbs indicates that this file may be, for example, one connected to a series of links and arguments related to the Automotive Industry. The user may choose to click on the Linked Terms (Hobbs, column 15, lines 64-65), and the browser window may be divided into four frames as shown in FIGURE 10 of Hobbs. Thus, the viewer can view simultaneously "the results of his or her search in frame 1 **500**, determine via frame 2 **501** ...which database has been selected... and view the surrounding 25 to 30 words surrounding the highlighted text in frame 3 **502** (Hobbs, column 23, lines 40-46). By clicking on the highlighted selection in frame 3, the user may return to the original full text of the document being viewed and scroll to the exact place in the full text document where the Linked Term occurs (Hobbs, column 23, lines 46-50). Even if, *arguendo*, Hobbs teaches embedding a search link into a document, Hobbs' method still fails to teach or suggest that this step is performed "in response to the determination that the test search results are desirable," as recited by applicants' claims. Thus, Hobbs does not teach or suggest the last step in applicants' Claim 1, and Hobbs does not teach or suggest both a test search result and a search result. Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Hobbs should be withdrawn.

Independent Claim 29 distinguishes over Hobbs for reasons similar to those noted above in connection with Claim 1. Accordingly, the rejection of independent Claim 29 under 35 U.S.C. § 102(e) over Hobbs should be withdrawn.

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Because dependent claims inherently include all of the elements of the independent claims from which the dependent claims ultimately depend and because Hobbs does not disclose or suggest all of the elements of independent Claims 1 and 29, the rejection of dependent Claims 2, 5, 7-8, 11, 13, 21, 27, 30, 33, 35, and 38 under 35 U.S.C. § 102(e) over Hobbs should be withdrawn for at least the same reasons as the rejections of Claims 1 and 29.

Claims Rejected Under 35 U.S.C. § 103(a)

Claims 9, 14, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobbs. However, Claims 9, 14, and 37 depend from independent Claims 1 and 29, which are patentable for the reasons discussed above. Because dependent claims inherently include all of the elements of the independent claims from which the dependent claims depend, dependent Claims 9, 14, and 37 are patentable for at least the same reasons discussed above with regard to independent Claims 1 and 29. Accordingly, the rejection of dependent Claims 9, 14, and 37 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 3, 4, 6, 12, 28, 31, 32, 34, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobbs in view of Pub. No. U.S. 2001/0044833 (Eisendrath et al.). However, Claims 3, 4, 6, 12, 28, 31, 32, 34, and 36 depend from independent Claims 1 and 29, which are patentable for the reasons discussed above. Accordingly, the rejection of dependent Claims 3, 4, 6, 12, 28, 31, 32, 34, and 36 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 16 and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobbs and further in view of Hara et al. (U.S. Patent No. 6,427,145, hereinafter "Hara"). However, Claims 16 and 40 depend from independent Claims 1 and 29, which are patentable for the reasons discussed above. Accordingly, the rejection of dependent Claims 16 and 40 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 22 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobbs and further in view of Chang et al. (U.S. Patent No. 5,321,833, hereinafter "Chang"). However, Claims 22 and 39 depend from independent Claims 1 and 29, which are patentable for the reasons discussed above. Accordingly, the rejection of dependent Claims 22 and 39 under 35 U.S.C. § 103(a) should be withdrawn.

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In view of the amendments and Remarks set forth above, it will be apparent that the claims in this application define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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